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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHOWDHURY, SUMAIYA A

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,747

Applicant(s)

WACHTFOGEL ET AL.

Examiner

Sumaiya A. Chowdhury

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-92, 145 and 162-193 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 85-92, 145, 162-193 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 85-92, and 145, in the reply filed on 8/9/06 is acknowledged.
2. Claims 93-104, 146 and 147, withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/9/06.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 85-88, 91-92, 145, 162-164, and 167-193, are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (6,698,020).

As for claim 85, Zigmond teaches a method for displaying advertisements transmitted to a user unit, the method comprising:

receiving, at the user unit, at least one advertisement tagged with a delay tag indicating whether display of the at least one advertisement can be delayed – (The

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advertisements are received at the home entertainment system, in which they are either stored for later display or displayed immediately. Since the receiver determines whether or not the advertisements should be stored for later display, there is a delay tag which indicates so - col. 4, lines 18-24); and

only if said delay tag allows delaying display of said at least one advertisement:

storing (advertisement source 62) said at least one advertisement at the user unit – col. 4, lines 18-24;

retrieving said at least one advertisement – col. 4, lines 18-24; and

displaying said at least one advertisement – col. 4, lines 18-24, lines 35-39, lines 44-49, col. 7, lines 25-30.

As for claims 86 and 162, Zigmond teaches:

Wherein the controller is operative to display said at least one advertisement without delay if said delay tag does not allow delaying display of said at least one advertisement – col. 16, lines 1-12.

As for claims 87 and 163, Zigmond teaches wherein said delay tag also indicates whether a user of the user unit can control display of said at least one advertisement, and said displaying comprises:

only if said delay tag indicates that the user can control display of said at least one advertisement:

retrieving said at least one advertisement in response to a selection made

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by the user – col. 8, lines 18-21, col. 9, lines 28-31; and

displaying said at least one advertisement – col. 8, lines 18-21.

As for claims 88 and 164, Zigmond teaches wherein said delay tag also indicates a maximum allowed delay time period for displaying said at least one advertisement, and said displaying comprises:

displaying said at least one advertisement after said maximum allowed delay time period elapses if said at least one advertisement had not been displayed before said maximum allowed delay time period elapsed – (An advertiser specifies that its advertisement be shown during a particular program. During the broadcast of a 30 minute program, if the advertisement is not displayed yet, it will be displayed before the expiry of the 30 minutes. - col. 12, lines 54-60).

As for claims 91 and 167, Zigmond teaches wherein said delay tag is assigned a guaranteed delivery attribute (payment by advertiser) that forces the at least one advertisement to be displayed eventually – col. 14, lines 52-56.

As for claims 92 and 168, Zigmond teaches wherein said delay tag is assigned the guaranteed delivery attribute in response to a payment for assigning the guaranteed delivery attribute – col. 14, lines 52-56.

As for claims 145 and 169, Zigmond discloses a user unit for displaying transmitted advertisements, the user unit comprising:

a receiver (60 - Fig. 7) operative to receive at least one advertisement tagged with a delay tag indicating whether display of the at least one advertisement can be delayed (The advertisements are received at the home entertainment system, in which they are either stored for later display or displayed immediately. Since the receiver determines whether or not the advertisements should be stored for later display, there is a delay tag which indicates so - col. 4, lines 18-24);

a memory (86 - Fig. 5);

a display (58 - Fig. 7) ; and

a controller (90 - Fig. 5) operatively associated with said receiver, said memory and said display and operative to store said at least one advertisement in said memory only if said delay tag allows delaying display of said at least one advertisement, and to retrieve said at least one advertisement from said memory for displaying said at least one advertisement on the display - col. 4, lines 18-24, lines 35-39, lines 44-49, col. 7, lines 25-30, col. 15, lines 55-65.

As for claims 170 and 182, Zigmond teaches wherein the at least one advertisement comprises the following:

A video clip (video - col. 11, lines 10-12);

Audio (col. 11, lines 10-12); and

A combination comprising at least two of the following:

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A video clip (video – col. 11, lines 10-12);

Audio (col. 11, lines 10-12).

As for claims 171 and 183, Zigmond teaches assigning the delay tag a value which is dependent on a length of the at least one advertisement – (The delay code is embedded in the programming which pauses the programming for the length of the advertisement - col. 16, lines 35-42).

As for claims 172 and 184, Zigmond teaches wherein the delay tag indicates that display of the at least one advertisement can be delayed when the at least one advertisement is 30 seconds long - col. 16, lines 35-42.

As for claims 173 and 185, Zigmond teaches wherein the delay tag indicates that display of the at least one advertisement cannot be delayed when the at least one advertisement is less than 30 seconds long - col. 16, lines 35-42.

As for claim 174 and 186, Zigmond teaches associating the delay tag with a commercial length tag which defines a length of the at least one advertisement - col. 16, lines 35-42.

As for claims 175 and 187, Zigmond teaches enabling a user of the user unit to determine for how long the user wishes to delay display of the at least one

advertisement (Since the user selects when to view the advertisement, the user determines how long to delay the display of the advertisement – col. 9, lines 28-31).

As for claim 176 and 188, Zigmond teaches storing configuration information (software for displaying video programming and ads; program code for executing selected steps) of the user unit – col. 6, lines 40-67.

As for claims 177 and 189, Zigmond teaches wherein the configuration information comprises an indication of whether a user delay option is allowed (Since the user is allowed to delay display of the advertisement, it is inherent that the configuration information comprises an indication of whether a user delay option is allowed - col. 16, lines 35-42).

As for claims 178 and 190, Zigmond teaches wherein the configuration information comprises an indication of a maximum number of user delays per day (The maximum number of delay codes received in a day is the max number of delays per day – col. 16, lines 33-43).

As for claims 179 and 191, Zigmond teaches storing current user interactivity information – col. 9, lines 20-38, col. 11, lines 13-20.

As for claims 180 and 192, Zigmond teaches the current user interactivity information comprises a number of advertisement delays executed in a current day (The delay code is embedded in the programming. Therefore, the number of commercial shown to the user in a day is the number of advertisements delayed in a day. – col. 16, lines 33-43).

As for claims 181 and 193, Zigmond teaches wherein the current user interactivity information comprises a number of delays executed upon the at least one advertisement – (Delay it once to display the ad - col. 16, lines 35-42).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 89-90, and 165-166, are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Berezowski (6,075,551).

As for claims 89 and 165, Zigmond fails to teach wherein said delay tag also indicates a non-advertising programming (NAP) threshold defining a maximum amount

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of NAP that may be displayed before the at least one advertisement must be displayed, and said displaying comprises:

determining an amount of NAP that has already been displayed; and displaying said at least one advertisement without delay if said amount of NAP that has already been displayed is greater than or equal to the NAP threshold.

In an analogous art, Berezowski teaches advertisements are inserted at specified start times (after maximum amount of NAP has been displayed) – col. 4, lines 4-15, col. 6, lines 45-59, col. 7, lines 4-20.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Zigmond's invention to include the abovementioned limitations, as taught by Berezowski, in order to have advertisements properly spaced out.

As for claims 90 and 166, Zigmond fails to teach wherein said amount of NAP is defined by an accumulated time of display of NAP.

In an analogous art, Berezowski that after a certain amount of NAP is displayed, the advertisement is displayed. - col. 4, lines 4-15, col. 6, lines 45-59, col. 7, lines 4-20.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Zigmond's invention to include the abovementioned limitations, as taught by Berezowski, in order to have advertisements properly spaced out.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumaiya A. Chowdhury whose telephone number is (571) 272-8567. The examiner can normally be reached on Mon-Fri, 9-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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